

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 12, 2005. At the time of the Office Action, Claims 1-32 were pending in the Application. Applicant amends Claims 1, 8, 15, 21, and 27 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Consideration of Information Disclosure Statement

Applicant has submitted an Information Disclosure Statement (IDS) with this Response. Applicant respectfully requests the Examiner to review this IDS and to formally indicate that these materials have been considered in the context of the pending prosecution. Applicant suggests the Examiner use a PTO-1449 to provide written notification to this effect.

Section 102 Rejection

The Examiner rejects Claims 1-6 and 8-32 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0266426 issued to Marsh et al. (hereinafter "Marsh"). This rejection is respectfully traversed for the following reasons.

Once again Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

establish the inherency of that result or characteristic.”³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Marsh is simply flawed because it does not disclose any teaching of a ***mobile station being coupled to a first pathway, which is used for signaling data, and a second pathway, which is different from the first pathway and which is used for voice data, the features being enabled by a feature server that is coupled to the IP PBX and that is operable to deliver the features to the mobile station in real-time.*** Independent Claim 1, as amended, includes this recitation.

As a preliminary matter, there is nothing in *Marsh* that offers such a two-pathway architecture. *Marsh*’s disclosure reinforces this point in explaining: “The legs 342D and 152C as well as the legs 342E and 152D are common to both the paths 152 and 342 and perform like functions in each path.” (See *Marsh*, paragraph 0090.) This is also evidenced by FIGURES 6 and 20, which are the very FIGURES on which the Examiner has chosen to rely. Thus, there are no *separate pathways for signaling and for voice*, as any type of data can propagate on either leg. Indeed, the architecture of *Marsh* relies on the fact that there is no difference in these two legs. This distinction is important because the terminal devices are configured to coordinate two separate pathways, which reduces processing cycles and overhead.

Moreover, there is no feature delivery capability present in *Marsh*: much less use of a feature server that is coupled to an IP PBX, much less a feature server that can offer any features in real-time. While *Marsh* attempts to mimic certain rudimentary options (e.g. caller ID) by creating an ‘artificial caller ID’ (e.g. leveraging signaling or tones, etc.), this is not the same as delivering the features of one network to another network, much less delivering those features in real-time. All of these options of *Marsh* are coordinated in a cumbersome fashion because there are no separate pathways for voice and signaling.

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

These more complicated operations disclosed by *Marsh* are provided to overcome its inability to optimally deliver features from the private network. While it is true that *Marsh* can facilitate a connection from a legacy platform to a dual-mode subscriber device, *how* that is being done in *Marsh* is not akin to the operations circumscribed by the pending Independent Claims. Moreover, because of its configuration, *Marsh* can only provide a simple link for such a communication session involving the dual-mode subscriber device, but it cannot actually deliver the features of the private network.

Note that the Examiner should appreciate the significance of a separate signaling pathway in an arrangement that is highlighted by the pending subject matter. The configuration of the present invention allows the enterprise system to establish a voice path between the private and public network using a voice network. The separate signaling path may enable enhanced signaling to deliver private network information to the mobile station by establishing a data connection from the IP PBX to the mobile station. Applicant has made an amendment to the Independent Claims to further elucidate this point, but in actuality, this amendment was not necessary in light of the cited Prior Art.

By providing a seamless transition between networks, the enterprise system can provide a common set of private network features to the mobile station regardless of whether the mobile station receives service from the private or the public network. Such a scenario could not be facilitated without a separate signaling pathway (i.e. it would be impossible in the architecture of *Marsh*). This feature further provides that a given end user does not sacrifice processing time or inhibit his own versatility in being able to enjoy the advantages of both systems.

For at least these reasons, Independent Claim 1 is clearly patentable over *Marsh*. In addition, Independent Claims 8, 15, and 21 include a similar set of limitations and, thus, are also allowable using analogous reasoning.

Accordingly, all of the pending claims have been shown to be allowable, as they are patentable over the cited references. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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PATENT APPLICATION
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15

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$180.00 to cover the cost of the IDS filing fee. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,
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